UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,486	04/25/2001	Yasuo Iwasa	Q63961	4521

65565 7590 09/10/2009

SUGHRUE-265550
2100 PENNSYLVANIA AVE. NW
WASHINGTON, DC 20037-3213

EXAMINER	
VO, HAI	

ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
09/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YASUO IWASA and SHIGEKAZU OI

Appeal 2008-001008
Application 09/841,486

Oral Hearing Held: Tuesday, July 7, 2009

Before CHUNG K. PAK, JEFFREY T. SMITH and MARK NAGUMO, Administrative Patent Judges

ON BEHALF OF THE APPELLANTS:

JENNIFER M. HAYES, ESQ.
Sughrue Mion, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
(202) 663-7404

The above-entitled matter came on for hearing on Tuesday, July 7, 2009, commencing at 1:17 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, 9th Floor, Hearing Room A, Alexandria, Virginia, before Kevin Carr, Notary Public.

THE USHER: Calendar 10, Mrs. Hayes.

JUDGE PAK: Welcome, Ms. Hayes.

MRS. HAYES: Thank you.

JUDGE PAK: Today we have a court reporter, Mr. Carr, who is going to transcribe the entire hearing. That transcript will become part of the record. You have 20 minutes and you can start any time you wish.

MRS. HAYES: Okay. I'd like to start off by saying good afternoon. I am Jennifer Hayes here representing on this case, which is Serial Number 09/841,486. Pretty much, I think, we were kind of down to maybe I think perhaps issues with the claim limitations pretty much set forth in Claim 1 where the claim, "a self-supporting stretched force resin film. It is obtained from a compound that is needed and then it is intermeshed with a turn-screw extruder. And the film itself has a liquid absorbing capacity specified in the claims of 0.5 milliliters to over per meter squared, or as measured in accordance with the method specified in the Japan TAPPI standard as recited in claim 1.

And we have a rejection based on Arai, which is a WO publication, but the U.S. reference, 6,632,487 is considered as the English equivalent. So it references in the briefs as well as today what I'll refer to the U.S. '487 patent. And the main issue, I believe, is the 102 or alternative 103 rejection based on Arai. And our position pretty much is that the

limitations of self-supporting stretched and film are structural limitations, which should be given weight that the Examiner appears to disagree with us on. The first one, which I think is quite clear, is the issue of the term "stretched." The Examiner takes the position that this is a process limitation; and, our position is that it is a structural limitation because it is known in the art that when you stretch a resin film that it changes the molecular orientation of the film, and that stretching gives it different physical properties and it is a structural limitation. The art does not teach stretching, no desire, no discussion, no contemplation whatsoever of stretching.

JUDGE NAGUMO: Well, doesn't the art though take the film and push it through a pair of rollers? And that would have the same effect?

MRS. HAYES: I don't believe that. It's a spray coating. They coat this. They spray the coating onto a substrate, and then they heat it. Well, maybe in some embodiments they may, you know, roll it through.

JUDGE PAK: When you look at Arai's figure 3 together with Arai's column 12, element 35, which is called "a fixing roller," I guess it pushes in or stretches a resin film.

MRS. HAYES: I wouldn't necessarily say that under the terms of, you know, whether or not it necessarily stretched. It's fixed. It's used to heat it and fix it to the substrate, and that's clear throughout the whole description of in the '487 patent, that the whole idea of using the heat is to enhance its adhesion to the substrate. It's not for purposes of stretching, and there's no indication that by simply rolling it through that it gets somewhat laminated onto the substrate for adhesion purposes, but not necessarily stretched in terms of changing its specific molecular orientation.

JUDGE NAGUMO: But if I roll out pie dough, you know, I'm thinning it. When I do it I'm adhering it to my counter, but I'm also stretching it.

MRS. HAYES: Pie dough has a different consistency than a powdery coating, which is what this layer is.

JUDGE NAGUMO: Well, it's not a powdered coating at this stage, is it?

MRS. HAYES: At which stage?

JUDGE NAGUMO: I mean it's been melted and now you seem to have a film that you're fixing. It's not pressing sugar crystals to keep on the MSP 100.

MRS. HAYES: They describe it as a dry-coated on the surface of a substrate, melted by heating, and then fixed.

JUDGE NAGUMO: They say "melted by heating," so it's now a thermal-plastic film that I'm pushing between two rollers; and, why is that not sufficient stretching?

MRS. HAYES: It could be considered as a film. I think that's clear, but it says it's "provided between the particles of the powdery coating composition to form space, at least in part there between." So it's not necessarily a totally cohesive film in the sense of our, you know, compared to what we're claiming. I think that in addition to the fact that we have the stretching, it's also self-supporting in the claimed invention, and this powdery coating cannot be self-supporting at all.

JUDGE NAGUMO: Well, not when it's a powder, but it doesn't remain a powder.

MRS. HAYES: Even when it's fixed, they discuss in column 10 about how, if you put too much in it or too little in it, it could peel off. But it doesn't indicate that it's self-supporting as if it could be used as a sheet for the purpose by which the patent is directed to a sheet. I think it's an inkjet. I know ours in an inkjet sheet, and you could not take that coating itself, melted or not melted, and then use it as a sheet for purposes of what the patent is for.

JUDGE SMITH: Do you have a description that tells us what the language "self-supporting" means?

MRS. HAYES: Yes. At page 24 of our specification it describes the film as being where it says that "It can be applied on a substrate and can serve as it is." Also at page 27; the first one is page 24, lines 5 to 8; and page 27, lines 1 to 2, it also refers to the film being used "as such," meaning as an independent film, not necessarily laminated on something else.

JUDGE NAGUMO: What evidence would you point us to in Arai that the film that's made from the powder is melted and processed is not self-supporting? We know that it doesn't characterize it as such, but if it forms a continuous film, why wouldn't we expect it to be self-supporting?

MRS. HAYES: Well, one other thing I think that indicates that is the amount of the inorganic powder that's in this composition. The amount of the inorganic powder is put in there to cause spaces; and, there is more of the inorganic powder than it is of the resin in this film.

JUDGE NAGUMO: Well, we make meshes all the time that have much more space than material. That would show perhaps that it's

certainly porous, which is another requirement that you have. But what other evidence would you point to as evidence that Arai doesn't teach a self-supporting film?

MRS. HAYES: Well, once again, I go back to the amount of the composition of the inorganic powder in column 10. They describe how if you have too little of it, you can't fix it on the substrate by heating. If you have too much of it, then it will peel off, and that's not what they're trying to do. They're trying to get it to adhere to the substrate. It's described as a powdery coating that they spray onto the substrate and then they use it as a laminated sheet; and ours is an individual layer or individual film made of this composition, which is stretched and is used; you know, as an ink absorbing sheet and an inkjet.

JUDGE NAGUMO: Yeah, but if I put on enough that it's so thick that it peels off, that peeled off film would appear to be self-supporting.

MRS. HAYES: I don't know if I would say peeled-off is self-supporting. Like, for instances, if you make -- excuse my reference here to cooking -- but if you make like macaroni and you get that little film in it, it will peel off of the side of the pot; but, it's not self-supporting. You couldn't do anything with it. It's pliable. It's not a self-supporting sheet that you would try to use in an inkjet situation.

JUDGE NAGUMO: I think that's where Judge Smith was heading with his questions. How much self-supporting character did he need? If I could hold it up, show it to you, that might be self-supporting.

MRS. HAYES: Well, I think you have to look at it in the context of the art in which it's being used, and it's being used as a sheet by itself for inkjet recording. And this peeled off layer, if in fact, which is also they're teaching away from that in the first place, because it's not what they're trying to get.

JUDGE NAGUMO: Well, you do have recitations of properties in the claim. What would you direct our attention to as evidence that the films in Arai do not have the properties that you recite in the film?

MRS. HAYES: The fact that it's not stretched? The fact that the composition of the inorganic particles is more than the composition of the resin layer and the fact that it's not self-supporting. It's not an individual layer. It is used and fixed onto the substrate. The powdery coating that's sprayed on and then is heated to be melted and adhere to the substrate. And it's never used by itself as a separate layer.

JUDGE SMITH: What language in your claim restricts the use of a laminate?

MRS. HAYES: I don't think we restrict the use of a laminate. I mean, it's clear in our specification that we can use this in a laminate, and I think we even have claims later on. Also, claim 21 is one where we use the layer in a laminate, which the Examiner found to be allowable -- claims 20 and 21, which are not actually on appeal right now -- because they were found to have allowable subject matter.

JUDGE NAGUMO: But we're not going to read limitations into the claim, so are we down to a finding that Arai does not teach these films having these properties?

MRS. HAYES: Right. It does not teach a stretched, self-supporting film that has the properties of the liquid absorbing capacity.

JUDGE NAGUMO: And why would it not have the liquid, absorbing capacity? It appears to be made out of similar materials, the hydrophilic and non-hydrophilic, thermoplastic resins. That part appears to be clear and undisputed.

MRS. HAYES: Yes, I think that is clear that the composition is similar in the sense that it is hydrophilic and a hydrophobic.

JUDGE NAGUMO: Why would it not have this liquid absorbing capacity? Half a mil per meter, a meter is large. Half a mil is quite small. You don't need a whole lot of absorptivity here.

MRS. HAYES: Well, the reference is silent as to that; and, therefore, it would be on the burden of the PTO to show that there's some reasonable basis for believing that the reference also has the same property; but it's not made the same. The composition is not exactly the same and it's not stretched. It's not self-supporting. It's a powdery composition that's melted onto a substrate. There'd be no reason to believe that that alone has the absorption capacity of our film.

JUDGE PAK: Counsel, when you say self-supporting, are you trying to say it's capable of being self-supporting or are you saying that means without a laminate, without a substrate?

MRS. HAYES: Right. I'm saying it means without.

JUDGE PAK: It means, because you are relying on page 24 of the specification, the language, SEDs, as the basis for surface coating.

MRS. HAYES: Right, as well as page 27.

JUDGE PAK: You would use the same language.

MRS. HAYES: Right.

JUDGE PAK: As opposed to "alternatively combined with the substrate."

MRS. HAYES: Right. See, the Examiner's position, as I understand it is that it's not the whole sheet that he's claiming or that he is asserting renders the claims anticipated or obvious. It's just the one powdery layer.

JUDGE PAK: Yeah, so your statement is that the claim excludes the sheet to which the powdery layer is affixed.

MRS. HAYES: Yes, this claim is only referring to if you were to compare. If you were trying to say it's a 101 comparison, which I'm not so sure I would necessarily say, but just for purposes of explanation, our film would be comparable to the powdery coating layer -- not the entire sheet, not the base -- because we can put our film on a base and have a laminate. But that's not what claim 1 is referring to.

JUDGE PAK: Claim 1 is limited to one without the laminate.

MRS. HAYES: Right.

JUDGE PAK: Anyone have a question?

JUDGE SMITH: The liquid, absorbent capacity does not appear to be tied to stretching, according to page 25 of your specification. Do you agree?

MRS. HAYES: Let me look at this real quick, please. Page 25?

JUDGE SMITH: Line 4 of that paragraph.

MRS. HAYES: Well, stretching is a preferred embodiment, which is the embodiment that we're claiming at line 10. Because line 4, they just basically say that "The film, having a capacity, can be produced by known film formation techniques." Then it goes through a list of them, including stretching, calendaring, et cetera. And it says at 10, "stretching method is preferred," to get the results and the specific desired properties.

JUDGE NAGUMO: It also mentions weight-containing particles.

MRS. HAYES: Yes, there is some inorganic particles, I believe.

JUDGE NAGUMO: So that would feed into Arai's teaching of inorganic particles.

MRS. HAYES: What line are you referring to, please?

JUDGE NAGUMO: That would be line 7 to 8: "Method used in voids containing particles to create the liquid absorptivity."

MRS. HAYES: Well, yes. That is a method that can be used, but the composition would still have to have. It doesn't give you a specific amount, so the composition would still have to have a certain amount of void containing particles or not above a certain amount in order for it to work. It doesn't mean that the whole thing could be void containing particles, and it could still be stretched and still have the same water absorbing capacity.

JUDGE PAK: Any questions?

JUDGE NAGUMO: No.

JUDGE PAK: Thank you for coming.

MRS. HAYES: Thank you.

The hearing was concluded at 1:37 p.m.